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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,851	06/20/2001	Alan Brett Conley	50325-0553	6237
29989	7590	06/15/2004	EXAMINER LEROUX, ETIENNE PIERRE	
HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125			ART UNIT 2171	PAPER NUMBER 12

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,851

Applicant(s)

CONLEY ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17 is/are rejected.
- 7) ☒ Claim(s) 18-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections:

Claims 18-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Election/Restriction

Applicant elected claims 13-23 with traverse. Applicant subsequently maintained that the restriction is improper. Examiner is not convinced.

MPEP § 803 states:

Criteria For Restriction between Patentably Distinct Inventions

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05 (i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

Guidelines

Examiners must provide reasons and/or examples to support conclusions but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. If there is an

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express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a).

The originally filed claims would have presented an undue burden on the examiner. The claims as originally filed comprise ten(10) pages with a plurality of claim elements and a plurality of relationships between the elements. For example, dependent claim 18, comprises a page-and-a-half with at least thirty-five elements and the relationship between these elements. Claim 18 depends from claim 13 which comprises at least an additional 15 unique claim elements and the relationship(s) between these claim elements. Examiner was granted only the standard time for examination of instant application which clearly is not enough time to do a quality examination. Examiner would have had to spend many additional hours in order to do a quality examination of the ten(10) pages of claims as originally filed. This would have presented an undue burden on the examiner. Furthermore, an undue burden is placed on the examiner due to separate classifications of the independent claims and hence separate searches, and since applicant fails to rebut the restriction by appropriate showings or evidence, the restriction is deemed proper and is maintained.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,009,081 issued to Wheeler et al (hereafter Wheeler).

Claim 13:

Wheeler discloses:

- automatically generating network site and site link information from a router configuration file [col 14, line 59, col 17, lines 13-45] for use in a directory service by reading preprocessing information
- the preprocessing information including override information for nullifying information associated with one or more sites or one or more site links from one or more configuration files [customers routed over provider's network [col 14, line 60-65]
- reading router interface information from router configuration file associated with each of the one or more routers, wherein one or more site references is generated by identifying a sub-network on a Local Area Network (LAN) [Fig 10, 100] interface and one or more site link references by identifying a Wide Area Network (WAN) interface [Fig 10, 162] wherein the override information is applied to the site and site link references [col 14, line 55 through col 15, line 9]

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler.

Claim 14:

Wheeler discloses the elements of claim 13 as noted above.

Wheeler fails to disclose reading a list of one or more router names from a source, wherein the source is a network management system, a database, or a router query result, generating a router name from the router configuration file associated with each of the one or more routers, comparing the one or more router names from the router configuration files to the list of one or more router names from the source and upon a router name from the router

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configuration files not being in the list of one or more router names from the source, generating an exception.

However, Wheeler discloses an exception database [col 17, lines 46- 52].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wheeler to include reading a list of one or more router names from a source, wherein the source is a network management system, a database, or a router query result, generating a router name from the router configuration file associated with each of the one or more routers, comparing the one or more router names from the router configuration files to the list of one or more router names from the source and upon a router name from the router configuration files not being in the list of one or more router names from the source, generating an exception.

The ordinarily skilled artisan would have been motivated to modify Wheeler per the above for the purpose of providing a heuristic mechanism by which the invention determines that an entity is connected to the public network access point and is peering with public network access point providers [col 17, line 55].

4. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler in view of US Pat No 4,853,843 issued to Ecklund (hereafter Ecklund).

Claim 15:

Wheeler discloses the elements of claims 13 and 14 as noted above.

Wheeler fails to disclose generating a temporary site name for each router name from the router configuration file associated with each of the one or more routers, and associating each of

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the one or more site references determined from the router configuration file associated with each of the one or more routers with the temporary site name for the associated router.

Ecklund discloses a temporary site name [col 16, lines 13-27].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wheeler and Ecklund to include generating a temporary site name for each router name from the router configuration file associated with each of the one or more routers, and associating each of the one or more site references determined from the router configuration file associated with each of the one or more routers with the temporary site name for the associated router.

The ordinarily skilled artisan would have been motivated to modify Wheeler per the above for the purpose of processing requests when failures occur [col 16, line 14].

Claim 16:

Wheeler discloses the elements of claims 13-15 as noted above.

Wheeler fails to disclose generating a partial site link for each of the one or more site link references determined from the router configuration file associated with each of the one or more routers and associating each partial site link with the temporary name for the associated router.

Ecklund discloses a temporary site name [col 16, lines 13-27].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wheeler and Ecklund to include generating a partial site link for each of the one or more site link references determined from the router configuration file associated with each of the one or more routers and associating each partial site link with the temporary name for the associated router.

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The ordinarily skilled artisan would have been motivated to modify the combination of Wheeler and Ecklund per the above for the purpose of processing requests when failures occur [col 16, line 14].

Claim 17:

The combination of Wheeler and Ecklund discloses the elements of claims 13-16 as noted above.

The combination of Wheeler and Ecklund fails to disclose generating a sub-network reference based on each of one or more “ip route” commands in the router configuration file associated with each of the one or more routers, and associating each sub-network reference with the temporary site name for the associated router.

However, Wheeler discloses a router has a plurality of unique IP addresses that identify it, one for each of the directly connected networks [col 5, lines 47-49].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Wheeler and Ecklund to include generating a sub-network reference based on each of one or more “ip route” commands in the router configuration file associated with each of the one or more routers, and associating each sub-network reference with the temporary site name for the associated router.

The ordinarily skilled artisan would have been motivated to modify the combination of Wheeler and Ecklund per the above for the purpose of providing a routing protocol [col 6, lines 13-20].

Response to Arguments

Applicant's arguments filed 4/23/2004 have been fully considered but are not persuasive.

Applicant Argues:

Applicant states in the paragraph linking pages 18 and 19 "The citations of Wheeler (col 10, lines 7-17 and line 54: Fig 4; col 9, lines 15-22) that allegedly anticipate Claim 13 do not disclose (1) automatically generating network site and site link information (2) from a router configuration file (3) for use in a directory service as recited in claim 13. Furthermore, Wheeler does not disclose the specific actions recited in Claim 13, such as (4) reading override information for nullifying information, from router configuration files, associated with site links: and (5) reading router interface information from a router configuration file to generate site and site link references."

Examiner Responds:

Examiner is not persuaded. Applicant states in the paragraph linking pages 19 and 20 that Wheeler does not teach the limitations of claim 13. Examiner is perplexed as Wheeler's disclosure relevant to claim 13, is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

6/9/2004




SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100